



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: DAVID P. LOBECK
Serial No.: 09/683,787
Filed: February 14, 2002
For: GOLF PRACTICE DEVICE

Examiner: D'Agostino, Paul Anthony
Group Art Unit: 3713

The Commissioner of Patents
and Trademarks
Alexandria, VA 22313

RE-INSTATED BRIEF OF APPELLANT

Sir:

This is an appeal from the third Final Rejection of the Examiner, dated August 28, 2008, rejecting Claims 1 to 6 and 9 to 22.

(i) Real party in interest

The real party in interest is the inventor, David P. Lobeck.

(ii) Related appeals and interferences

There are no related appeals or interferences.

(iii) Status of claims

Claims 1 to 20 were filed with the application.

Claims 7 and 8 were canceled.

Claims 21 and 22 were added by amendment.

Claims 1 to 6 and 9 to 22 were rejected.

Claims 1 to 6 and 9 to 22 are appealed.

(iv) *Status of amendments*

No amendment was filed after the third Final Rejection.

(v) *Summary of claimed subject matter*

The independent claims are Claims 1, 13, and 18.

Claim 1

Claim 1 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (B) an electronic sound generator (a printed circuit board (PCB), Figure 2, number 11) that generates a sound when energized by the battery (paragraph 9, lines 14 to 15, and paragraph 11, lines 1 to 2);
- (C) a single sensor switch (Figures 2, number 18) that closes an electrical circuit connecting the battery to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (D) an on-off switch (Figures 2 and 3, number 12) that enables the user of the golf practice device to turn the golf practice device on or off (paragraph 9, lines 4 to 8).

The base is either a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2) or material made of small hooks (Figure 4, number 28) that can be releasably attached to a fabric (paragraph 14, lines 1 to 3).

Claim 13

Claim 13 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;
- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery

(Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2).

Claim 18

Claim 18 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;

- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a material made of small hooks (Figure 4, number 28, paragraph 14, lines 1 to 4).

Claims 5, 15, and 20 are separately argued.

Claim 5

Claim 5 depends from Claim 1 but specifies that the sound is that of a ball falling into a cup. (Figure 2, numbers 9 and 11, paragraph 11).

Claims 15 and 20 are identical to Claim 5, but depend from Claims 13 and 18, respectively.

(vi) Grounds of rejection to be reviewed on appeal

- I. Claims 1, 3, 4, 10, 12, 13, 18, and 22 have rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso.
- II. Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee.
- III. Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox.
- IV. Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams.

(vii) Argument

I. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso)

(A) Claims 1, 3, 4, 10, 12, 13, 18, and 22

Bart, the principal reference, discloses a “novelty toy” (col. 1, line 17, and col. 2, line 35) that produces an audio message when struck. The toy includes a band that snaps into either a coiled position or an elongated position. The Examiner views the housing by itself (without the band) as similar to Appellant’s devise. The Examiner concedes, however, that Bart does not show an on-off switch or a base that is either a pin that can be pushed into the ground or material made of small hooks (e.g., “Velcro”) that can be releasably attached to a fabric.

Wash was cited to show an on-off switch on a golf putting training device. Wash’s device is quite different from Appellant’s device. In Appellant’s device, the golfer hits a ball at the devise, trying to hit the devise with the ball; lights and sound are produced if he does so. In the Wash devise, a “reflecting surface,” such as a convex mirror, is mounted on the front of the putter. The golfer rotates the putter head until “an

encoded infrared optical signal" (col. 3, line 1) from the devise reflects off the reflecting surface back to a "receiving means" (col. 3, line 2) on the devise, which produces a "correct alignment alarm." (Col. 7, lines 55-56). If the golfer now swings his putter, the device will tell him if the putter head is still aligned at the time it would hit a golf ball. (Col. 8, lines 25-27). No golf ball is needed to use the Wash devise. (Col. 7, lines 29-30) and, although Wash says that his devise can be used with a golf ball (col. 7, lines 29-30), it is hard to see how the devise would work if there is a golf ball in between the putter head and the devise, blocking the light. Also, striking a golf ball with a mirror attached to the putter head may damage the mirror. Bart's devise is of no use when the putting green is not level because the putter head would have to be mis-aligned in order to hit the ball so that it goes into the cup.

Wash's devise is large and can easily accommodate his on-off switch, which is large enough to be easily moved with a finger (#14 in Figure 3). But there is no room for Wash's on-off switch in Bart's toy. The housing of Bart's toy must be small so that it can be attached to his band and worn on a child's wrist. The "speaker, the battery, and the read-only memory chip containing the pre-recorded message" in Bart's toy are "miniaturized." (Col. 1, lines 59 to 60). The speaker, which is almost as large as the housing (Figure 7) is only 29 mm in diameter. (Col. 4, lines 55 to 56). Thus, Wash's on-off switch cannot be simply added to Bart's toy, but would require extensive changes in Bart's toy, making the toy significantly larger, more expensive, and less suitable as a toy for children; Wash's on-off switch would also detract from the appearance of Bart's toy.

Also, when Wash's device is on, it continuously sends out an infrared optical signal. Wash's on-off switch must be turned "off" to stop the device from sending out the infrared optical signal. Thus, without an on-off switch, Wash's battery would soon be drained. In Bart's toy, however, the toy is always off, except when it is struck. Thus, there is no need for an on-off switch on Wash's toy.

If Appellant's device did not have an on-off switch, every small bump would set it off as it is being carried around, annoying other people and embarrassing the person carrying it. That is not a problem with Bart's novelty toy as the toy is supposed to turn on as it is being carried around and bumped. Also, if Bart's toy is accidentally activated, it would be humorous, not a social crisis. For these reasons, there is no need for an on-off switch on Bart's toy and it would not be obvious to put Wash's on-off switch into Bart's toy.

Durso is cited to show a golf swing touch trainer "wherein the base can include spiking into the ground." (Page 5 of Office Action). However, what Durso actually says is that his devise is portable, but "may be fastened to a surface more permanently such as by spiking, gluing, ..." (Col. 3, lines 20-22). One would not glue the devise to the ground, so it cannot be said that Durso shows spiking "into the ground." (On page 6 of his Office Action the Examiner concedes that Durso "is silent on whether the base includes a spike.")

Durso does show (col. 3, lines 23-29) having a material made of small hooks that can be releasably attached to a fabric, e.g., "Velcro." The Examiner argues that it would be obvious to use "Velcro" on the base of Bart's toy and omit the special band. Appellant does not agree. Bart's toy is specifically made to attach to a special band that

can be snapped into one of two positions – straight and curved to fit around a wrist. Bart provides a slot (#16A in Figure 4) that is specially designed to accommodate the arcuate shape of that band so that the band stays in the slot without any need to attach it to the housing. (“The arcuate shape of the spring band 12 provides a natural securing feature which secures spring band 12 to the housing 16 without the need for any additional securing devices.” (Col. 3, lines 54 to 56.)

If a spike or hooked material is attached to the bottom of Bart’s toy instead of using the special band, the devise will not be able to function the way it is designed to function, that is, by slapping the band in its linear shape against the wrist, causing it to change into its circular shape. That special band and the way it functions is the most important part of Bart’s invention, and to replace it with a spike or “Velcro” would completely eviscerate Bart’s invention.

In addition, Bart says (column 3, lines 41 to 44), “Once the band is dynamically deployed by striking the middle of it against an object such as your wrist or forearm, the entire metal band 12 will coil (as shown in FIG. 5) around the wrist, forearm or other body part of the user.” Thus, the middle of the band must be exposed and cannot be covered by a spike, pin, or hooked material. Bart’s devise is called “SLAP WRAP” (col. 1, lines 29-31) because, when the band is in its linear shape, one end of the band is grasped and the band and housing unit are slapped against the wrist or other object, causing the band to wrap around the wrist (or other object). (Col. 5, lines 33-39.) That cannot be done if there is a spike or hooked material at the point of impact. Thus, it is not obvious to attach a spike, pin, or hooked material to the bottom of Bart’s housing.

It is well settled that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As argued hereinabove, the incorporation of Durso's "Velcro" into Bart's toy would change the principles that Bart's toy operates on and therefore such a combination would not be obvious.

II. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,584,768 (Lee)

Claims 2, 11, and 17

Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee. Bart, Wash, and Durso have been discussed. Lee is cited to show a pin, but is not otherwise relevant, and the non-obviousness of attaching a spike to Bart's device, which is similar to a pin, was discussed hereinabove.

III. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,067,718 (Knox)

(A) Claims 5, 6, 15, 16, 20, and 21

Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox. Bart, Wash, and Durso

have been discussed. Knox was cited as teaching the sound of a human voice in response to a putted ball, but is not otherwise relevant.

(B) Claims 5, 15, and 20

Claims 5, 15, and 20 do not stand or fall with the remaining claims in this rejection because these claims require the sound to be "that of a ball falling into a cup." While Bart's toy does make a sound (col. 5, lines 58-59), it is not obvious to have it make the sound of a ball falling into a cup because Bart's device is a toy for children, who normally do not play golf.

IV. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 2,184,868 (Williams)

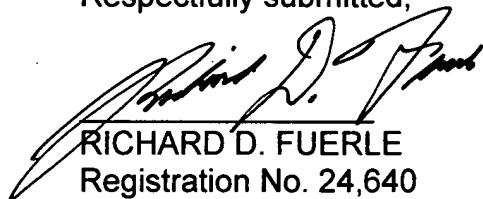
Claims 9, 14, and 19

Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams. Bart, Wash, and Durso have been discussed. Williams was cited to show a spring and ferrule sensor switch. The Examiner notes that in Williams the spring is outside the ferrule, but in Appellant's claims the spring is inside the ferrule. The Examiner states, "It would have been obvious ... to reverse the parts ..." Appellant does not agree. With the spring on the outside, as in Williams, the electrically conductive spring can come into contact with other metal parts, perhaps setting off a false "hit." That could be prevented by insulating the outside of the spring while leaving the inside of the spring un-insulated, but it is difficult to insulate only the outside of a spring. Appellant's design avoids that problem as the spring can be left un-insulated and it is easy to insulate only the outside of the

cylindrical ferrule, though insulation would not even be needed as the ferrule does not move but the spring does. Thus, it is not obvious to put the spring inside the ferrule, as required by Appellant's Claims 9, 14, and 19.

For these reasons, it is submitted that Appellants' invention is not obvious over the references cited. The Board is therefore requested to reverse the Examiner and allow Claims 1 to 6 and 9 to 22. Three copies of this Brief are enclosed.

Respectfully submitted,



RICHARD D. FUERLE
Registration No. 24,640
For Appellant

Richard D. Fuerle
1711 West River Road
Grand Island, NY 14072
(716)-774-0091
CASE DL01
November 3, 2008

(viii) Claims appendix

1. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
 - (I) said head portion contains
 - (A) at least one battery;
 - (B) an electronic sound generator that generates a sound when energized by said battery; and
 - (C) a single sensor switch that closes an electrical circuit connecting said battery to said electronic sound generator when said golf practice device is struck by a golf ball coming from any direction; and
 - (D) an on-off switch that enables the user of said golf practice device to turn said golf practice device on or off; and
 - (II) said base is selected from the group consisting of a pin that can be pushed into the ground and material made of small hooks that can be releasably attached to a fabric.
 2. A golf practice device according to Claim 1 wherein said base is a pin that can be pushed into the ground.

 3. A golf practice device according to Claim 1 wherein said base is a material made of small hooks, whereby said golf practice device can be releasably attached to a fabric.

 4. A golf practice device according to Claim 1 wherein said sides that are struck by

said golf ball are cylindrical.

5. A golf practice device according to Claim 1 wherein said sound is that of a ball falling into a cup.
6. A golf practice device according to Claim 1 wherein said sound is a human voice.
7. (Canceled)
8. (Canceled)
9. A golf practice device according to Claim 1 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.
10. A golf practice device according to Claim 1 wherein said electronic sound generator is an integrated circuit for generating an electrical signal and a speaker for converting said electrical signal into sound.
11. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 2 into a putting green and putting golf balls at said golf practice device.

12. A method of improving putting accuracy comprising placing a golf practice device according to Claim 3 on a carpet and putting golf balls at said golf practice device.

13. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

- (I) said head portion contains
 - (A) an on-off switch that enables the user of said device to turn said device on and off;
 - (B) at least one battery;
 - (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;
 - (D) a speaker that generates a sound when energized by said electrical signal;
 - (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
 - (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when said on-off switch and said sensor switch are both closed; and
- (II) said base is a pin that can be pushed into the ground.

14. A golf practice device according to Claim 13 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

15. A golf practice device according to Claim 13 wherein said sound is that of a ball falling into a cup.

16. A golf practice device according to Claim 13 wherein said sound is that of a human voice.

17. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 13 into a putting green, turning on said on-off switch, and putting golf balls at said device.

18. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

(I) said head portion contains

- (A) an on-off switch that enables the user of said device to turn said device on and off;
- (B) at least one battery;
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;

- (D) a speaker that generates a sound when energized by said electrical signal;
- (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
- (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when both said on-off switch and said sensor switch are closed; and

(II) said base is a material made of small hooks that can be releasably attached to a fabric.

19. A golf practice device according to Claim 18 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

20. A golf practice device according to Claim 18 wherein said sound is that of a ball falling into a cup.

21. A golf practice device according to Claim 18 wherein said sound is that of a human voice.

22. A method of improving putting accuracy comprising placing a golf practice device according to Claim 18 on a carpet, turning on said on-off switch, and putting golf balls at said device.

(ix) Evidence appendix

None

(x) Related proceedings appendix

None



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: DAVID P. LOBECK

Examiner: D'Agostino, Paul Anthony

Serial No.: 09/683,787

Group Art Unit: 3713

Filed: February 14, 2002

For: GOLF PRACTICE DEVICE

The Commissioner of Patents
and Trademarks
Alexandria, VA 22313

RE-INSTATED BRIEF OF APPELLANT

Sir:

This is an appeal from the third Final Rejection of the Examiner, dated August 28, 2008, rejecting Claims 1 to 6 and 9 to 22.

(i) Real party in interest

The real party in interest is the inventor, David P. Lobeck.

(ii) Related appeals and interferences

There are no related appeals or interferences.

(iii) Status of claims

Claims 1 to 20 were filed with the application.

Claims 7 and 8 were canceled.

Claims 21 and 22 were added by amendment.

Claims 1 to 6 and 9 to 22 were rejected.

Claims 1 to 6 and 9 to 22 are appealed.

(iv) Status of amendments

No amendment was filed after the third Final Rejection.

(v) Summary of claimed subject matter

The independent claims are Claims 1, 13, and 18.

Claim 1

Claim 1 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (B) an electronic sound generator (a printed circuit board (PCB), Figure 2, number 11) that generates a sound when energized by the battery (paragraph 9, lines 14 to 15, and paragraph 11, lines 1 to 2);
- (C) a single sensor switch (Figures 2, number 18) that closes an electrical circuit connecting the battery to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (D) an on-off switch (Figures 2 and 3, number 12) that enables the user of the golf practice device to turn the golf practice device on or off (paragraph 9, lines 4 to 8).

The base is either a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2) or material made of small hooks (Figure 4, number 28) that can be releasably attached to a fabric (paragraph 14, lines 1 to 3).

Claim 13

Claim 13 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;
- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery

(Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2).

Claim 18

Claim 18 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;

- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a material made of small hooks (Figure 4, number 28, paragraph 14, lines 1 to 4).

Claims 5, 15, and 20 are separately argued.

Claim 5

Claim 5 depends from Claim 1 but specifies that the sound is that of a ball falling into a cup. (Figure 2, numbers 9 and 11, paragraph 11).

Claims 15 and 20 are identical to Claim 5, but depend from Claims 13 and 18, respectively.

(vi) Grounds of rejection to be reviewed on appeal

- I. Claims 1, 3, 4, 10, 12, 13, 18, and 22 have rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso.
- II. Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee.
- III. Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox.
- IV. Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams.

(vii) Argument

I. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso)

(A) Claims 1, 3, 4, 10, 12, 13, 18, and 22

Bart, the principal reference, discloses a “novelty toy” (col. 1, line 17, and col. 2, line 35) that produces an audio message when struck. The toy includes a band that snaps into either a coiled position or an elongated position. The Examiner views the housing by itself (without the band) as similar to Appellant’s devise. The Examiner concedes, however, that Bart does not show an on-off switch or a base that is either a pin that can be pushed into the ground or material made of small hooks (e.g., “Velcro”) that can be releasably attached to a fabric.

Wash was cited to show an on-off switch on a golf putting training device. Wash’s device is quite different from Appellant’s device. In Appellant’s device, the golfer hits a ball at the devise, trying to hit the devise with the ball; lights and sound are produced if he does so. In the Wash devise, a “reflecting surface,” such as a convex mirror, is mounted on the front of the putter. The golfer rotates the putter head until “an

encoded infrared optical signal" (col. 3, line 1) from the devise reflects off the reflecting surface back to a "receiving means" (col. 3, line 2) on the devise, which produces a "correct alignment alarm." (Col. 7, lines 55-56). If the golfer now swings his putter, the device will tell him if the putter head is still aligned at the time it would hit a golf ball. (Col. 8, lines 25-27). No golf ball is needed to use the Wash devise. (Col. 7, lines 29-30) and, although Wash says that his devise can be used with a golf ball (col. 7, lines 29-30), it is hard to see how the devise would work if there is a golf ball in between the putter head and the devise, blocking the light. Also, striking a golf ball with a mirror attached to the putter head may damage the mirror. Bart's devise is of no use when the putting green is not level because the putter head would have to be mis-aligned in order to hit the ball so that it goes into the cup.

Wash's devise is large and can easily accommodate his on-off switch, which is large enough to be easily moved with a finger (#14 in Figure 3). But there is no room for Wash's on-off switch in Bart's toy. The housing of Bart's toy must be small so that it can be attached to his band and worn on a child's wrist. The "speaker, the battery, and the read-only memory chip containing the pre-recorded message" in Bart's toy are "miniaturized." (Col. 1, lines 59 to 60). The speaker, which is almost as large as the housing (Figure 7) is only 29 mm in diameter. (Col. 4, lines 55 to 56). Thus, Wash's on-off switch cannot be simply added to Bart's toy, but would require extensive changes in Bart's toy, making the toy significantly larger, more expensive, and less suitable as a toy for children; Wash's on-off switch would also detract from the appearance of Bart's toy.

Also, when Wash's device is on, it continuously sends out an infrared optical signal. Wash's on-off switch must be turned "off" to stop the device from sending out the infrared optical signal. Thus, without an on-off switch, Wash's battery would soon be drained. In Bart's toy, however, the toy is always off, except when it is struck. Thus, there is no need for an on-off switch on Wash's toy.

If Appellant's device did not have an on-off switch, every small bump would set it off as it is being carried around, annoying other people and embarrassing the person carrying it. That is not a problem with Bart's novelty toy as the toy is supposed to turn on as it is being carried around and bumped. Also, if Bart's toy is accidentally activated, it would be humorous, not a social crisis. For these reasons, there is no need for an on-off switch on Bart's toy and it would not be obvious to put Wash's on-off switch into Bart's toy.

Durso is cited to show a golf swing touch trainer "wherein the base can include spiking into the ground." (Page 5 of Office Action). However, what Durso actually says is that his devise is portable, but "may be fastened to a surface more permanently such as by spiking, gluing, ..." (Col. 3, lines 20-22). One would not glue the devise to the ground, so it cannot be said that Durso shows spiking "into the ground." (On page 6 of his Office Action the Examiner concedes that Durso "is silent on whether the base includes a spike.")

Durso does show (col. 3, lines 23-29) having a material made of small hooks that can be releasably attached to a fabric, e.g., "Velcro." The Examiner argues that it would be obvious to use "Velcro" on the base of Bart's toy and omit the special band. Appellant does not agree. Bart's toy is specifically made to attach to a special band that

can be snapped into one of two positions – straight and curved to fit around a wrist.

Bart provides a slot (#16A in Figure 4) that is specially designed to accommodate the arcuate shape of that band so that the band stays in the slot without any need to attach it to the housing. (“The arcuate shape of the spring band 12 provides a natural securing feature which secures spring band 12 to the housing 16 without the need for any additional securing devices.” (Col. 3, lines 54 to 56.)

If a spike or hooked material is attached to the bottom of Bart’s toy instead of using the special band, the devise will not be able to function the way it is designed to function, that is, by slapping the band in its linear shape against the wrist, causing it to change into its circular shape. That special band and the way it functions is the most important part of Bart’s invention, and to replace it with a spike or “Velcro” would completely eviscerate Bart’s invention.

In addition, Bart says (column 3, lines 41 to 44), “Once the band is dynamically deployed by striking the middle of it against an object such as your wrist or forearm, the entire metal band 12 will coil (as shown in FIG. 5) around the wrist, forearm or other body part of the user.” Thus, the middle of the band must be exposed and cannot be covered by a spike, pin, or hooked material. Bart’s devise is called “SLAP WRAP” (col. 1, lines 29-31) because, when the band is in its linear shape, one end of the band is grasped and the band and housing unit are slapped against the wrist or other object, causing the band to wrap around the wrist (or other object). (Col. 5, lines 33-39.) That cannot be done if there is a spike or hooked material at the point of impact. Thus, it is not obvious to attach a spike, pin, or hooked material to the bottom of Bart’s housing.

It is well settled that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As argued hereinabove, the incorporation of Durso's "Velcro" into Bart's toy would change the principles that Bart's toy operates on and therefore such a combination would not be obvious.

II. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,584,768 (Lee)

Claims 2, 11, and 17

Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee. Bart, Wash, and Durso have been discussed. Lee is cited to show a pin, but is not otherwise relevant, and the non-obviousness of attaching a spike to Bart's device, which is similar to a pin, was discussed hereinabove.

III. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,067,718 (Knox)

(A) Claims 5, 6, 15, 16, 20, and 21

Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox. Bart, Wash, and Durso

have been discussed. Knox was cited as teaching the sound of a human voice in response to a putted ball, but is not otherwise relevant.

(B) Claims 5, 15, and 20

Claims 5, 15, and 20 do not stand or fall with the remaining claims in this rejection because these claims require the sound to be "that of a ball falling into a cup." While Bart's toy does make a sound (col. 5, lines 58-59), it is not obvious to have it make the sound of a ball falling into a cup because Bart's device is a toy for children, who normally do not play golf.

IV. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 2,184,868 (Williams)

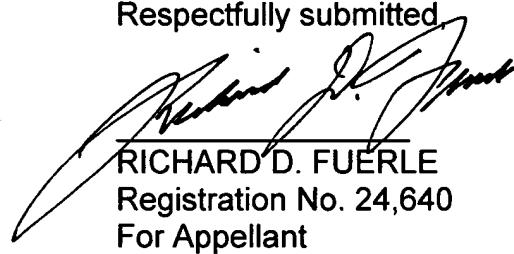
Claims 9, 14, and 19

Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams. Bart, Wash, and Durso have been discussed. Williams was cited to show a spring and ferrule sensor switch. The Examiner notes that in Williams the spring is outside the ferrule, but in Appellant's claims the spring is inside the ferrule. The Examiner states, "It would have been obvious ... to reverse the parts ..." Appellant does not agree. With the spring on the outside, as in Williams, the electrically conductive spring can come into contact with other metal parts, perhaps setting off a false "hit." That could be prevented by insulating the outside of the spring while leaving the inside of the spring un-insulated, but it is difficult to insulate only the outside of a spring. Appellant's design avoids that problem as the spring can be left un-insulated and it is easy to insulate only the outside of the

cylindrical ferrule, though insulation would not even be needed as the ferrule does not move but the spring does. Thus, it is not obvious to put the spring inside the ferrule, as required by Appellant's Claims 9, 14, and 19.

For these reasons, it is submitted that Appellants' invention is not obvious over the references cited. The Board is therefore requested to reverse the Examiner and allow Claims 1 to 6 and 9 to 22. Three copies of this Brief are enclosed.

Respectfully submitted,



RICHARD D. FUERLE
Registration No. 24,640
For Appellant

Richard D. Fuerle
1711 West River Road
Grand Island, NY 14072
(716)-774-0091
CASE DL01
November 3, 2008

(viii) Claims appendix

1. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
 - (I) said head portion contains
 - (A) at least one battery;
 - (B) an electronic sound generator that generates a sound when energized by said battery; and
 - (C) a single sensor switch that closes an electrical circuit connecting said battery to said electronic sound generator when said golf practice device is struck by a golf ball coming from any direction; and
 - (D) an on-off switch that enables the user of said golf practice device to turn said golf practice device on or off; and
 - (II) said base is selected from the group consisting of a pin that can be pushed into the ground and material made of small hooks that can be releasably attached to a fabric.
 2. A golf practice device according to Claim 1 wherein said base is a pin that can be pushed into the ground.

 3. A golf practice device according to Claim 1 wherein said base is a material made of small hooks, whereby said golf practice device can be releasably attached to a fabric.

 4. A golf practice device according to Claim 1 wherein said sides that are struck by

said golf ball are cylindrical.

5. A golf practice device according to Claim 1 wherein said sound is that of a ball falling into a cup.
6. A golf practice device according to Claim 1 wherein said sound is a human voice.
7. (Canceled)
8. (Canceled)
9. A golf practice device according to Claim 1 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.
10. A golf practice device according to Claim 1 wherein said electronic sound generator is an integrated circuit for generating an electrical signal and a speaker for converting said electrical signal into sound.
11. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 2 into a putting green and putting golf balls at said golf practice device.

12. A method of improving putting accuracy comprising placing a golf practice device according to Claim 3 on a carpet and putting golf balls at said golf practice device.

13. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

- (I) said head portion contains
 - (A) an on-off switch that enables the user of said device to turn said device on and off;
 - (B) at least one battery;
 - (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;
 - (D) a speaker that generates a sound when energized by said electrical signal;
 - (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
 - (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when said on-off switch and said sensor switch are both closed; and
- (II) said base is a pin that can be pushed into the ground.

14. A golf practice device according to Claim 13 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

15. A golf practice device according to Claim 13 wherein said sound is that of a ball falling into a cup.

16. A golf practice device according to Claim 13 wherein said sound is that of a human voice.

17. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 13 into a putting green, turning on said on-off switch, and putting golf balls at said device.

18. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

(I) said head portion contains

- (A) an on-off switch that enables the user of said device to turn said device on and off;
- (B) at least one battery;
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;

- (D) a speaker that generates a sound when energized by said electrical signal;
- (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
- (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when both said on-off switch and said sensor switch are closed; and

(II) said base is a material made of small hooks that can be releasably attached to a fabric.

19. A golf practice device according to Claim 18 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

20. A golf practice device according to Claim 18 wherein said sound is that of a ball falling into a cup.

21. A golf practice device according to Claim 18 wherein said sound is that of a human voice.

22. A method of improving putting accuracy comprising placing a golf practice device according to Claim 18 on a carpet, turning on said on-off switch, and putting golf balls at said device.

(ix) Evidence appendix

None

(x) Related proceedings appendix

None



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: DAVID P. LOBECK

Examiner: D'Agostino, Paul Anthony

Serial No.: 09/683,787

Group Art Unit: 3713

Filed: February 14, 2002

For: GOLF PRACTICE DEVICE

The Commissioner of Patents
and Trademarks
Alexandria, VA 22313

RE-INSTATED BRIEF OF APPELLANT

Sir:

This is an appeal from the third Final Rejection of the Examiner, dated August 28, 2008, rejecting Claims 1 to 6 and 9 to 22.

(i) Real party in interest

The real party in interest is the inventor, David P. Lobeck.

(ii) Related appeals and interferences

There are no related appeals or interferences.

(iii) Status of claims

Claims 1 to 20 were filed with the application.

Claims 7 and 8 were canceled.

Claims 21 and 22 were added by amendment.

Claims 1 to 6 and 9 to 22 were rejected.

Claims 1 to 6 and 9 to 22 are appealed.

(iv) *Status of amendments*

No amendment was filed after the third Final Rejection.

(v) *Summary of claimed subject matter*

The independent claims are Claims 1, 13, and 18.

Claim 1

Claim 1 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (B) an electronic sound generator (a printed circuit board (PCB), Figure 2, number 11) that generates a sound when energized by the battery (paragraph 9, lines 14 to 15, and paragraph 11, lines 1 to 2);
- (C) a single sensor switch (Figures 2, number 18) that closes an electrical circuit connecting the battery to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (D) an on-off switch (Figures 2 and 3, number 12) that enables the user of the golf practice device to turn the golf practice device on or off (paragraph 9, lines 4 to 8).

The base is either a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2) or material made of small hooks (Figure 4, number 28) that can be releasably attached to a fabric (paragraph 14, lines 1 to 3).

Claim 13

Claim 13 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;
- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery

(Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a pin (Figures 1 and 2, number 4) that can be pushed into the ground (paragraph 8, lines 1 to 2).

Claim 18

Claim 18 is directed to a golf practice device. The device has a body that has vertical sides (Figure 1, numbers 3 and 4) that can be struck by a moving golf ball. The body has a head portion (Figure 1, number 3, Figure 4, number 27, paragraph 9, line 1, paragraph 14, line 2) and a base (Figures 1 and 2, number 4, Figure 4, number 28, paragraph 14, line 2). The head portion contains

- (A) an on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8) that enables the user to turn the device on and off;
- (B) at least one battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9);
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by the battery (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15);
- (D) a speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15) that generates a sound when energized by the electrical signal;

- (E) a single sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11) that closes an electrical circuit connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9) to the electronic sound generator (paragraph 9, lines 9 to 11) when the device is struck by a golf ball coming from any direction (paragraph 3, line 3, paragraph 13, lines 3 to 4); and
- (F) an electrical circuit (Figures 2 and 3, number 20, paragraph 9, lines 11 and 12 and paragraph 10, lines 1 to 7) connecting the battery (Figures 2 and 3, number 13, paragraph 9, lines 8 to 9), the on-off switch (Figures 2 and 3, number 12, paragraph 9, lines 4 to 8), the sensor switch (Figures 2, number 18, paragraph 9, lines 9 to 11), the integrated circuit chip (a printed circuit board (PCB), Figure 2, number 11, paragraph 9, lines 2 to 4 and 14 to 15), and the speaker (Figure 2, number 9, paragraph 9, lines 2, 14, and 15), whereby the circuit is closed only when the on-off switch and the sensor switch are both closed (Figure 3, numbers 12 and 18); and

(II) the base is a material made of small hooks (Figure 4, number 28, paragraph 14, lines 1 to 4).

Claims 5, 15, and 20 are separately argued.

Claim 5

Claim 5 depends from Claim 1 but specifies that the sound is that of a ball falling into a cup. (Figure 2, numbers 9 and 11, paragraph 11).

Claims 15 and 20 are identical to Claim 5, but depend from Claims 13 and 18, respectively.

(vi) Grounds of rejection to be reviewed on appeal

- I. Claims 1, 3, 4, 10, 12, 13, 18, and 22 have rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso.
- II. Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee.
- III. Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox.
- IV. Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams.

(vii) Argument

I. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso)

(A) Claims 1, 3, 4, 10, 12, 13, 18, and 22

Bart, the principal reference, discloses a “novelty toy” (col. 1, line 17, and col. 2, line 35) that produces an audio message when struck. The toy includes a band that snaps into either a coiled position or an elongated position. The Examiner views the housing by itself (without the band) as similar to Appellant’s devise. The Examiner concedes, however, that Bart does not show an on-off switch or a base that is either a pin that can be pushed into the ground or material made of small hooks (e.g., “Velcro”) that can be releasably attached to a fabric.

Wash was cited to show an on-off switch on a golf putting training device. Wash’s device is quite different from Appellant’s device. In Appellant’s device, the golfer hits a ball at the devise, trying to hit the devise with the ball; lights and sound are produced if he does so. In the Wash devise, a “reflecting surface,” such as a convex mirror, is mounted on the front of the putter. The golfer rotates the putter head until “an

encoded infrared optical signal" (col. 3, line 1) from the devise reflects off the reflecting surface back to a "receiving means" (col. 3, line 2) on the devise, which produces a "correct alignment alarm." (Col. 7, lines 55-56). If the golfer now swings his putter, the device will tell him if the putter head is still aligned at the time it would hit a golf ball. (Col. 8, lines 25-27). No golf ball is needed to use the Wash devise. (Col. 7, lines 29-30) and, although Wash says that his devise can be used with a golf ball (col. 7, lines 29-30), it is hard to see how the devise would work if there is a golf ball in between the putter head and the devise, blocking the light. Also, striking a golf ball with a mirror attached to the putter head may damage the mirror. Bart's devise is of no use when the putting green is not level because the putter head would have to be mis-aligned in order to hit the ball so that it goes into the cup.

Wash's devise is large and can easily accommodate his on-off switch, which is large enough to be easily moved with a finger (#14 in Figure 3). But there is no room for Wash's on-off switch in Bart's toy. The housing of Bart's toy must be small so that it can be attached to his band and worn on a child's wrist. The "speaker, the battery, and the read-only memory chip containing the pre-recorded message" in Bart's toy are "miniaturized." (Col. 1, lines 59 to 60). The speaker, which is almost as large as the housing (Figure 7) is only 29 mm in diameter. (Col. 4, lines 55 to 56). Thus, Wash's on-off switch cannot be simply added to Bart's toy, but would require extensive changes in Bart's toy, making the toy significantly larger, more expensive, and less suitable as a toy for children; Wash's on-off switch would also detract from the appearance of Bart's toy.

Also, when Wash's device is on, it continuously sends out an infrared optical signal. Wash's on-off switch must be turned "off" to stop the device from sending out the infrared optical signal. Thus, without an on-off switch, Wash's battery would soon be drained. In Bart's toy, however, the toy is always off, except when it is struck. Thus, there is no need for an on-off switch on Wash's toy.

If Appellant's device did not have an on-off switch, every small bump would set it off as it is being carried around, annoying other people and embarrassing the person carrying it. That is not a problem with Bart's novelty toy as the toy is supposed to turn on as it is being carried around and bumped. Also, if Bart's toy is accidentally activated, it would be humorous, not a social crisis. For these reasons, there is no need for an on-off switch on Bart's toy and it would not be obvious to put Wash's on-off switch into Bart's toy.

Durso is cited to show a golf swing touch trainer "wherein the base can include spiking into the ground." (Page 5 of Office Action). However, what Durso actually says is that his devise is portable, but "may be fastened to a surface more permanently such as by spiking, gluing, ..." (Col. 3, lines 20-22). One would not glue the devise to the ground, so it cannot be said that Durso shows spiking "into the ground." (On page 6 of his Office Action the Examiner concedes that Durso "is silent on whether the base includes a spike.")

Durso does show (col. 3, lines 23-29) having a material made of small hooks that can be releasably attached to a fabric, e.g., "Velcro." The Examiner argues that it would be obvious to use "Velcro" on the base of Bart's toy and omit the special band. Appellant does not agree. Bart's toy is specifically made to attach to a special band that

can be snapped into one of two positions – straight and curved to fit around a wrist. Bart provides a slot (#16A in Figure 4) that is specially designed to accommodate the arcuate shape of that band so that the band stays in the slot without any need to attach it to the housing. (“The arcuate shape of the spring band 12 provides a natural securing feature which secures spring band 12 to the housing 16 without the need for any additional securing devices.” (Col. 3, lines 54 to 56.)

If a spike or hooked material is attached to the bottom of Bart’s toy instead of using the special band, the devise will not be able to function the way it is designed to function, that is, by slapping the band in its linear shape against the wrist, causing it to change into its circular shape. That special band and the way it functions is the most important part of Bart’s invention, and to replace it with a spike or “Velcro” would completely eviscerate Bart’s invention.

In addition, Bart says (column 3, lines 41 to 44), “Once the band is dynamically deployed by striking the middle of it against an object such as your wrist or forearm, the entire metal band 12 will coil (as shown in FIG. 5) around the wrist, forearm or other body part of the user.” Thus, the middle of the band must be exposed and cannot be covered by a spike, pin, or hooked material. Bart’s devise is called “SLAP WRAP” (col. 1, lines 29-31) because, when the band is in its linear shape, one end of the band is grasped and the band and housing unit are slapped against the wrist or other object, causing the band to wrap around the wrist (or other object). (Col. 5, lines 33-39.) That cannot be done if there is a spike or hooked material at the point of impact. Thus, it is not obvious to attach a spike, pin, or hooked material to the bottom of Bart’s housing.

It is well settled that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As argued hereinabove, the incorporation of Durso's "Velcro" into Bart's toy would change the principles that Bart's toy operates on and therefore such a combination would not be obvious.

II. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,584,768 (Lee)

Claims 2, 11, and 17

Claims 2, 11, and 17 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Lee. Bart, Wash, and Durso have been discussed. Lee is cited to show a pin, but is not otherwise relevant, and the non-obviousness of attaching a spike to Bart's device, which is similar to a pin, was discussed hereinabove.

III. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 5,067,718 (Knox)

(A) Claims 5, 6, 15, 16, 20, and 21

Claims 5-6, 15-16, and 20 to 21 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Knox. Bart, Wash, and Durso

have been discussed. Knox was cited as teaching the sound of a human voice in response to a putted ball, but is not otherwise relevant.

(B) Claims 5, 15, and 20

Claims 5, 15, and 20 do not stand or fall with the remaining claims in this rejection because these claims require the sound to be "that of a ball falling into a cup." While Bart's toy does make a sound (col. 5, lines 58-59), it is not obvious to have it make the sound of a ball falling into a cup because Bart's device is a toy for children, who normally do not play golf.

IV. Rejection under 35 U.S.C. 103(a) over U.S. Patent No. 6,220,916 (Bart) in view of U.S. Patent No. 5,692,966 (Wash) and U.S. Patent No. 5,779,567 (Durso) further in view of U.S. Patent No. 2,184,868 (Williams)

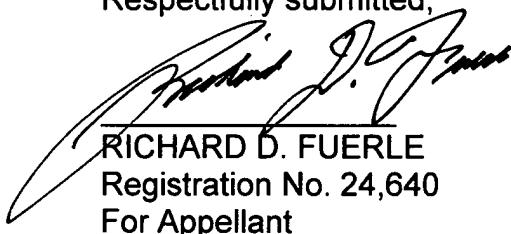
Claims 9, 14, and 19

Claims 9, 14, and 19 were rejected under 35 U.S.C. 103(a) as obvious over Bart in view of Wash and Durso, further in view of Williams. Bart, Wash, and Durso have been discussed. Williams was cited to show a spring and ferrule sensor switch. The Examiner notes that in Williams the spring is outside the ferrule, but in Appellant's claims the spring is inside the ferrule. The Examiner states, "It would have been obvious ... to reverse the parts ..." Appellant does not agree. With the spring on the outside, as in Williams, the electrically conductive spring can come into contact with other metal parts, perhaps setting off a false "hit." That could be prevented by insulating the outside of the spring while leaving the inside of the spring un-insulated, but it is difficult to insulate only the outside of a spring. Appellant's design avoids that problem as the spring can be left un-insulated and it is easy to insulate only the outside of the

cylindrical ferrule, though insulation would not even be needed as the ferrule does not move but the spring does. Thus, it is not obvious to put the spring inside the ferrule, as required by Appellant's Claims 9, 14, and 19.

For these reasons, it is submitted that Appellants' invention is not obvious over the references cited. The Board is therefore requested to reverse the Examiner and allow Claims 1 to 6 and 9 to 22. Three copies of this Brief are enclosed.

Respectfully submitted,



RICHARD D. FUERLE
Registration No. 24,640
For Appellant

Richard D. Fuerle
1711 West River Road
Grand Island, NY 14072
(716)-774-0091
CASE DL01
November 3, 2008

(viii) Claims appendix

1. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where
 - (I) said head portion contains
 - (A) at least one battery;
 - (B) an electronic sound generator that generates a sound when energized by said battery; and
 - (C) a single sensor switch that closes an electrical circuit connecting said battery to said electronic sound generator when said golf practice device is struck by a golf ball coming from any direction; and
 - (D) an on-off switch that enables the user of said golf practice device to turn said golf practice device on or off; and
 - (II) said base is selected from the group consisting of a pin that can be pushed into the ground and material made of small hooks that can be releasably attached to a fabric.
 2. A golf practice device according to Claim 1 wherein said base is a pin that can be pushed into the ground.

 3. A golf practice device according to Claim 1 wherein said base is a material made of small hooks, whereby said golf practice device can be releasably attached to a fabric.

 4. A golf practice device according to Claim 1 wherein said sides that are struck by

said golf ball are cylindrical.

5. A golf practice device according to Claim 1 wherein said sound is that of a ball falling into a cup.
6. A golf practice device according to Claim 1 wherein said sound is a human voice.
7. (Canceled)
8. (Canceled)
9. A golf practice device according to Claim 1 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.
10. A golf practice device according to Claim 1 wherein said electronic sound generator is an integrated circuit for generating an electrical signal and a speaker for converting said electrical signal into sound.
11. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 2 into a putting green and putting golf balls at said golf practice device.

12. A method of improving putting accuracy comprising placing a golf practice device according to Claim 3 on a carpet and putting golf balls at said golf practice device.

13. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

- (I) said head portion contains
 - (A) an on-off switch that enables the user of said device to turn said device on and off;
 - (B) at least one battery;
 - (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;
 - (D) a speaker that generates a sound when energized by said electrical signal;
 - (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
 - (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when said on-off switch and said sensor switch are both closed; and
- (II) said base is a pin that can be pushed into the ground.

14. A golf practice device according to Claim 13 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

15. A golf practice device according to Claim 13 wherein said sound is that of a ball falling into a cup.

16. A golf practice device according to Claim 13 wherein said sound is that of a human voice.

17. A method of improving putting accuracy comprising inserting the pin of a golf practice device according to Claim 13 into a putting green, turning on said on-off switch, and putting golf balls at said device.

18. A golf practice device comprising a body that has vertical sides that can be struck by a moving golf ball, said body having a head portion and a base, where

(I) said head portion contains

- (A) an on-off switch that enables the user of said device to turn said device on and off;
- (B) at least one battery;
- (C) an integrated circuit chip programmed to generate an electrical signal when energized by said battery;

- (D) a speaker that generates a sound when energized by said electrical signal;
- (E) a single sensor switch that closes an electrical circuit connecting said battery to said integrated circuit chip when a side of said golf practice device is struck by a golf ball coming from any direction; and
- (F) an electrical circuit connecting said battery, said on-off switch, said sensor switch, said integrated circuit chip, and said speaker, whereby said circuit is closed only when both said on-off switch and said sensor switch are closed; and

(II) said base is a material made of small hooks that can be releasably attached to a fabric.

19. A golf practice device according to Claim 18 wherein said sensor switch is a metal spring mounted inside a metal ferrule, so that said metal spring contacts said metal ferrule when said golf practice device is struck by a golf ball.

20. A golf practice device according to Claim 18 wherein said sound is that of a ball falling into a cup.

21. A golf practice device according to Claim 18 wherein said sound is that of a human voice.

22. A method of improving putting accuracy comprising placing a golf practice device according to Claim 18 on a carpet, turning on said on-off switch, and putting golf balls at said device.

(ix) Evidence appendix

None

(x) Related proceedings appendix

None